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09/787,750	05/21/2001	John Skalen	P/1629-43	6152

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT

PAPER NUMBER

3711

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15

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/787,750
Filing Date: May 21, 2001
Appellant(s): SKALEN, JOHN

Lawrence A. Hoffman
For Appellant

MAILED
APR 01 2003
GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/3/03.

A statement identifying the real party in interest is contained in the brief.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 6-11 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

GB 401,955	DEANE	11-1933
US 3,122,369	WINDALL	2-1964

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6,7 and 11 are rejected under 35 U.S.C. 103(a) as obvious over the British reference (Deane) in view of Windall. Deane discloses the elements of claim 1. However it does not clearly disclose the use of indicia placed on the tether. Windall teaches that it is desirable to provide indicia on the resilient line to enable an accurate indication of the distance of the drive (items 15, 17, 18 2:28-35)). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the indicia of Windall with the apparatus of Deane in order to permit the player to observe how far the ball would have theoretically traveled and increase the player's enjoyment of the game.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as unpatentable over the prior art cited in view of Official Notice. Note, that the applicant has clearly indicated that claims 8-10 stand or fall with claim 6. Official notice is given that any of a variety of means for attachment of balls and tethers are well known in the art. One of ordinary skill in the art would have selected an appropriate attachment means from one of the many prior art equivalent attachment means based on experience and costs, such as by an expansion means or a holding ring that is coupled to a corrugated fastener member located at the core of the ball as recited in claim 8, or a mounting hole with a greater diameter at an outer shell of said golf ball than at a center of said golf ball as recited in

claim 9, or wherein said rigid line is secured to said golf ball by a vulcanization process as recited in claim 10.

(11) Response to Argument

For the above reasons, it is believed that the rejections should be sustained.

The applicant argues that the novelty with the method of use for the instant invention should permit the apparatus to issue. The method of use of an invention does not dictate novelty of the apparatus.

In claim 6:

The instant invention claims	Deane discloses
A golf swing training device	A golf swing training device
a golf ball	a golf ball (item 3)
a rigid line	a non-resilient line (page 1, lines 25-28)
a resilient line that traverses said non-resilient line	a resilient line that traverses said non-resilient line (page 1, lines 50-51)
a ring that encloses said rigid line and resilient line.	a ring that encloses said non-resilient line and resilient line (12).
a plurality of indicators located on said rigid line	a plurality of indicators (page 3, lines 99-101)

Deans shows the indicia adjacent to the resilient line but does not disclose the use of indicia on the resilient line. Windall discloses placing indicia on the line. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the indicia of Windall with the apparatus of Deans in order to give an accurate estimate of the theoretical drive and increase the player's enjoyment of the game.

In claim 7:

The instant invention claims	Deane discloses
a length of said non-resilient line is approximately seven meters	a length of inelastic material (1:26)
a length of said resilient line is approximately five meters	a length of elastic material (1:36)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected an appropriate length for the elastic material such as five meters and to have selected an appropriate length for the non-elastic material such as seven meters so that the apparatus would operate in a correct manner, especially as it would appear that the device would perform equally well with any of a variety of lengths.

Claims 8-10 are rejected as admitted prior art directed towards the ball attachment means and are not addressed in this brief.

In claim 11:

The instant invention claims	Deane discloses
The training device controls the return of the ball and prevents the ball from reaching the player.	A purpose of this invention is to prevent the possibility on rebound of the ball from striking the player (1:20-25)

With respect to In re Miller and In re Gulack..

The arguments made are not understood because there is and was no "printed matter" rejection made. As noted above, the structure of the device is disclosed in the cited prior art. While applicant's brief on appeal presents arguments related to the intended operation of the instant device and the benefits of the intended use, it is submitted that the claims on appeal are obvious variations of the applied references.

Respectfully submitted,

Michael Chambers
Examiner
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March 17, 2003

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